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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,827	08/30/2000	Eric Schneider		1226

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ERIC SCHNEIDER
13944 CEDAR ROAD
258
UNIVERSITY HEIGHTS, OH 44118

EXAMINER

PRIETO, BEATRIZ

ART UNIT PAPER NUMBER

2142

DATE MAILED: 12/03/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,827

Applicant(s)

SCHNEIDER, ERIC

Examiner

B. Prieto

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____



DETAILED ACTION

1. This communication is in response to application No. 09/650,827 filed 08/30/00 claims 1-20 have been examined.
2. Acknowledgment is made of a claim for domestic priority under 35 U.S.C. 119(e) (to various provisional applications) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet complying with 37 CFR 1.78.
3. Drawings submitted on 08/30/00 were approved by Draftsperson.

Claim Rejection 35 U.S.C. 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-6, 9-13, and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Broadhurst U.S. Patent No. 6,560,634 B1.

Regarding claim 1, Broadhurst teaches substantial features of the invention as claimed, including a method for registering an identifier (Broadhurst: order form submission to appropriate registering service see col 6/lines 44-62) comprising the steps of:

selecting one first identifier from a selected first naming system from one of a plurality of registerable naming systems (108 of Fig. 1) (Broadhurst: submitting a selected domain name "first identifier", i.e. generating name via an user interface input and selecting a specified sub-domain ("first naming system" from a plurality of level domains naming systems see col 3/lines 25-50, and col 5/lines 28-42, see Figs. 5A-B, name input col 7/lines 41-46, see Fig. 4 select name step 408, and select domain naming system step 412);

determining whether said first identifier is available for registration (Broadhurst: available for registration response indication see col 6/lines 15-37, checking availability of domain names, col 2/lines 10-29);

selecting one second identifier from a selected first naming system from one of a plurality of registerable naming systems (108 of Fig. 1, multiple domains Figs. 5A-B) determining whether said second identifier is available for registration (Broadhurst: submitting a selected domain name "second identifier", i.e. generating name via an user interface input whether selected name is available for registration by submitting queries see col 3/lines 44-56, second selection see col 6/lines 65-67, second selection see col 7/lines 4-8); and,

registering at least one identifier in response to determining that said first identifier or said second identifier is available for registration (Broadhurst: register step see Fig. 6A, col 6/lines 51-67 register form Fig. 6C).

Regarding claim 2, wherein said first identifier and said second identifier are similar identifiers (Broadhurst: see Fig. 6A were user may select available identifiers (606), which include similar e.g. same names with different sub-domain extensions).

Regarding claim 3, wherein said first identifier includes a portion of said second identifier (Broadhurst: see Fig. 6A were user may select available identifiers (606), which include similar e.g. same names with different first or second sub-domain extensions, where first or second extension is the same).

Regarding claim 4, wherein said second identifier includes a portion of said first identifier (Broadhurst: see Fig. 6A where user may select available identifiers (606), same names with different first or second sub-domain extensions, where first or second extension is the same).

Regarding claim 5, wherein said step of selecting said first identifier further includes the step of generating said first identifier and said step of selecting said second identifier further includes the step of generating said second identifier from the first identifier (Broadhurst: selection of an identifier whether first or second includes a user entering a name via an user interface input "selecting a first identifier", includes generating name via an user interface input, e.g. command line and selecting from with a specified domain naming system from a plurality of country level domains see col 3/lines 25-50, and col 5/lines 28-42, see Figs. 5A-B or selecting an identifier whether first or second includes selecting from a list as shown on Fig. 6A).

Regarding claim 6, wherein said step of generating said first identifier and said second identifier further includes the step of generating the identifier by consulting from a namespace or identifier mapping, i.e. a list mapping the identifiers with the corresponding (namespace) domain name including an indication as to whether each listed identifier is available for registration as shown on Fig. 6A of Broadhurst).

Regarding claim 9, wherein said step of registering the identifier further includes the step of registering the identifier from an ("unified registration form") interface form (Broadhurst: Fig. 6A and 6C).

Regarding claim 10, further including the step of concurrently selecting from said first naming system and said second naming system (Broadhurst: concurrently selecting a plurality of naming system see Fig. 5A-B, user specifies ones of the domains see col 2/lines 42-53, selection of multiple Domain Name servers see col 5/lines 28-42).

Regarding claim 11, further including the step of concurrently selecting from said first identifier and said second identifier (Broadhurst: see Fig. 6C, multiple names allowed marked as "yes", and two domain name entry line shown).

Regarding claim 12, further including the step of concurrently determining whether said first identifier and said second identifier is available for registration (Broadhurst: submission of search requests to various DNS servers 108 in parallel see col 4/lines 4-16, Fig. 6C registration form allows multiple domain name entry, see multiple allowed marked as "yes", and two domain name entry lines shown).

Regarding claim 13, further including the step of concurrently registering said first identifier and said second identifier (Broadhurst: see Fig. 6C registration form allows multiple domain name entry, see multiple allowed marked as "yes", and two domain name entry lines shown).

Regarding claim 16, wherein said first identifier is a primary identifier and said first naming system is a primary naming system (Broadhurst: see Fig. 6C registration form allows two domain name entries, e.g. "a primary identifier" and see Fig. 5B, selection of a naming system consisting of the top 50 countries, "i.e. primary naming system", or user is allowed to create special domain names system to search, i.e. "primary naming system" see col 4/lines 33-31).

Regarding claim 17, further including the step of selecting said first identifier, said second identifier, and said primary identifier from one of a valid domain name (i.e. available) (Broadhurst: see Fig. 6A, user is allowed to select first and second identifiers as discussed on claims 13 and 16, said first and second identifiers from available domain names shown on the figure).

Regarding claim 18, further including the step of selecting said first naming system, said second naming system, and said primary naming system from one of a domain name system (Broadhurst: selective specified domains including sub-domains, i.e. "primary", "secondary" see col 5/lines 34-42).

Regarding claim 19, registering an identifier comprising:

a processor coupled to a memory and a browser for retrieving web content (Broadhurst: client computer (106 on Fig. 1) including a browser, i.e. stored on memory and executed by a processor see col 3/lines 25-37, see memory col 5/lines 1-7);

means for selecting a first naming system from one of a plurality of registerable naming systems (Broadhurst: browser program providing selecting means see col 3/lines 25-37, selecting functions see col 3/lines 25-50 and col 5/lines 28-42, Fig. 4 selecting identifier step 408 and selecting domain name step 412);

means for selecting at least one first identifier from said first naming system (Broadhurst: browser program see col 3/lines 25-37, search engine 222 providing from naming system selectable identifier in response to query see col 5/lines 13-col 6/lines 26);

means for determining whether said first identifier is available for registration (Broadhurst: query engine 222 including search engine 226 see col 4/lines 4-27, generating availability indication see col 6/lines 15-37);

means for selecting a second naming system from one of a plurality of registerable naming systems wherein said second naming system is a different naming system from said first naming system (Broadhurst: col 3/lines 25-50 and col 5/lines 28-42, select domain Fig. 4, step 412);

means for determining whether said second identifier is available for registration (Broadhurst: query engine 222 including search engine 226 see col 4/lines 4-27, generating availability indication see col 6/lines 15-37) and,

means for registering at least one identifier in response to determining that a said first identifier or said second identifier is available for registration (Broadhurst: Fig. 6C allows a user to register multiple different identifiers on multiple different domain name systems).

Regarding claim 20, this claim comprises the computer program product (Broadhurst: system, method and article of manufacture for teachings see col 2/lines 33-37, including software implementation see col 5/lines 1-7) for registering an identifier comprising the steps of discussed on claims 1 and 19, same rationale of rejection is applicable.

Claim Rejection 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadhurst in view of Poors Richard Web Site News, Kent, P., Top Floor Publishing, 1998, pages 1-3 (Kent hereafter).

Regarding claims 7-8, although Broadhurst teaches determining the availability for registry of multiple domain names and the selection of multiple domain names concurrently, he is silent in regards to automating the selection of a second identifier, particularly in response to a selected and available first identifier.

Kent discloses in regards to domain registration services, a WorldNIC domain name registration service that enables users to register multiple domains at once upon the selection of a first domain name. The registration service determines identifiers that are available for registration and suggest other available domain names to the user at the time of registration. When a user tries to register a domain name with a (e.g. .com) domain name level, the service system recommends registering at other domain names levels at the same time, enabling the user to select registering multiple domain names at multiple domain naming services all at once (see page 1-2).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given Broadhurst suggestion of selecting multiple domain names at different multiple domain levels at a domain name registration service provider, to look at pertinent prior art associated with registration service providers. Kent teaches selecting a second identifier in response to a selected and available first identifier. The automation of the registrations steps disclosed by both references would be readily apparent to one ordinary skilled in the art due to

the multiple selections the registrant is offered to choose, a browser that would make an easier, rapid and user friendly registration process would have been obvious in view of the prior art teachings. Motivation to combine the above-mentioned references would be to provide the registrant the flexibility to selectively perform automatic registration of other system generated domain names similar to a primary selected domain name at the time of registration, protecting said name from being used by others including any close variations to the selected name that the registrant may have overlooked.

8. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadhurst in view of Network Solutions, Inc., Online Team up to server Internet needs of small business owners, Jan. 1998, pages 1-2 (NSI hereafter).

Regarding claims 14-15, although Broadhurst teaches registering determined available identifiers, it does not explicitly teach allocating, i.e. reserving or releasing identifiers.

NSI, an Internet name registration provider discloses providing Internet name registration services that include the ability to register and reserve Internet names using a RegistrationPlus™ software for user from a desktop computer (see page 1-2);

It would have been obvious at the time the invention was made given the suggestion of Broadhurst for registering multiple domain names at multiple naming systems, to look at pertinent prior art associated with registration service providers. Existing service provides such a NSI enable a user to reserve domain names. Corresponding selectable counteraction to prior art's teachings such as releasing, deactivating or canceling said reservation actions to make available domain names the user has not intention to purchase would have been obvious to one skilled in the art. Motivation to combine the above mentioned references would be to enable a registrant to reserve domain names until are ready to activate them, e.g. the completion of a web site or in the case were the registrant is wait on the availability on domain names suspended and that have been currently placed on hold but will become available soon.

Pertinent Prior Art:

9. The following prior art made of record and not relied upon are considered pertinent to applicant's disclosure; pertinence is presented in accordance with MPEP§ 707.05. Copies of documents cited will be provided as set forth in MPEP§ 707.05(a):

CNET News.com: NSI domain slowdown persists, Goodin, D., Jan 1999, pages 1-4.

Goodin discloses current trend wherein NSI registry is flooded with request for popular domain names that are on hold but are expected to be available soon. Whois database provides an indication as to whether domain names have been placed on hold or when the domain name address queried was originally registered. This information, which deems a suspended domain name site as "on hold" for any number of reasons makes, is provide at the Whois database and indicates if a domain name will become available.

Windows IT Library: Domain Name Services, Northrup, T., July 1998, pages 1-41.

Northrup discloses determining whether a selected identifier is available for registration, wherein NSLookup enable an user via a command prompt to select multiple names and lookup the availability at a single time.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to the Central Fax Office:

(703) 872-9306, for Official communications and entry;

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington VA, Fourth Floor (Receptionist), further ensuring that a receipt is provided
stamped "TC 2100".



B. Prieto
TC 2100
Patent Examiner
November 28, 2003